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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
|-----------------|-------------|----------------------|---------------------|------------------|

10/712,722

11/13/2003

Wallace J. Maynard

E4919-00068

2200

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7590

10/31/2007

DUANE MORRIS, LLP

IP DEPARTMENT

30 SOUTH 17TH STREET

PHILADELPHIA, PA 19103-4196

EXAMINER

SHEWAREGED, BETELHEM

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

10/31/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/712,722

**Applicant(s)**

MAYNARD, WALLACE J.

**Examiner**

Betelhem Shewareged

**Art Unit**

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 and 6-15 is/are pending in the application.
- 4a) Of the above claim(s) 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6-12, 14 and 15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Applicant's response filed on 08/16/2007 has been fully considered. The Claim Objections have been withdrawn in view Applicant's comments and amendments.
2. Claims 1, 3, 6, 8, 11 and 14 are amended, claims 4 and 5 are canceled, claim 15 is added, and claims 1-3 and 6-15 are pending. Currently, claim 13 is withdrawn from consideration as non-elected invention.

### ***Election/Restrictions***

3. Applicant has failed to affirm the election in the reply to the Office Action mailed on 10/03/2005. Even though non-elected claim 13 has been identified as withdrawn claim, Applicant is still required to affirm the election. Applicant in replying to this Office Action must make affirmation of the election.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 2, 6, 8, 11, 12 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Hiatt et al. (US 6,254,970 B1).
6. Claims 1, 6, 8, 11, 12 and 14: Hiatt teaches a heat transfer label comprising a support portion and a transfer portion. The support portion comprises a substrate and

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an electron beam cured coating layer provided on the substrate (col. 4, line 12-30). The transfer portion is provided on the electron beam cured coating side of the support portion (Fig. 4). The transfer portion comprises an optional protective layer on the support portion and ink layer provided on the protective layer (col. 1, lines 23-28), and upon transferring the protective layer releases from the support portion without any wax residue (col. 3, lines 13-26).

7. Claim 2: Hiatt teaches a clay coated paper as the substrate (col. 1, line 32).

8. Claim 15 is rejected under 35 U.S.C. 102(b) as being anticipated by Hiatt et al. (US 6,254,970 B1).

9. Hiatt teaches a heat transfer label consisting of a support portion and a transfer portion. The support portion comprises a substrate and an electron beam cured coating layer provided on the substrate (col. 4, line 12-30). The transfer portion is provided on the electron beam cured coating side of the support portion (Fig. 4). The transfer portion comprises an optional protective layer on the support portion and ink layer provided on the protective layer (col. 1, lines 23-28), and upon transferring the protective layer releases from the support portion without any wax residue (col. 3, lines 13-26). Even though Hiatt teaches having an adhesive layer over the ink layer, the adhesive layer can be omitted because the layer is optional (col. 1, line 27).

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 7, 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hiatt et al. (US 6,254,970 B1) as applied to claim 1 above.

12. Hiatt teaches a heat transfer label as set forth above. Hiatt does not teach the thicknesses of the electron beam cured layer and the protective layer in terms of lbs/3,000 sq. ft as claimed. The experimental modification of this prior art in order to ascertain optimum operating conditions fails to render applicants' claims patentable in the absence of unexpected results. *In re Aller*, 105 USPQ 233. One of ordinary skill in the art would have been motivated to adjust the thickness of the layers in order to ease transferability of the transfer potion and to enhance the color density of the ink design layer. A prima facie case of obviousness may be rebutted, however, where the results of the optimizing variable, which is known to be result-effective, are unexpectedly good. *In re Boesch and Slaney*, 205 USPQ 215.

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13. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hiatt et al. (US 6,254,970 B1).

14. Hiatt teaches a heat transfer label comprising a support portion and a transfer portion. The support portion comprises a substrate and an electron beam cured coating layer provided on the substrate (col. 4, line 12-30). The transfer portion is provided on the electron beam cured coating side of the support portion (Fig. 4). The transfer portion comprises an optional protective layer on the support portion and ink layer provided on the protective layer (col. 1, lines 23-28), and upon transferring the protective layer releases from the support portion without any wax residue (col. 3, lines 13-26). Hiatt teaches a clay coated paper as the substrate.

15. Hiatt does not teach the basis weight of the paper in terms of lbs/3,000 sq. ft as claimed. The experimental modification of this prior art in order to ascertain optimum operating conditions fails to render applicants' claims patentable in the absence of unexpected results. *In re Aller*, 105 USPQ 233. One of ordinary skill in the art would have been motivated to adjust the basis weight of the paper so as to ease transferability of the transfer portion. A prima facie case of obviousness may be rebutted, however, where the results of the optimizing variable, which is known to be result-effective, are unexpectedly good. *In re Boesch and Slaney*, 205 USPQ 215.

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16. Claims 1, 6-12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over He et al. (US 2005/0100689 A1) in view of Hiatt et al. (US 6,254,970 B1).

17. Claims 1, 6, 8, 11, 12 and 14: He teaches a heat transfer label comprising a support portion and a transfer portion (abstract). The support portion comprises a paper substrate [0041] and release layer [0044]. The paper substrate is equivalent to the claimed first layer and the release layer is equivalent to the claimed second layer. The transfer portion comprises a wax layer [0061] and an ink design layer [0065]. The wax layer is equivalent to the claimed third layer. He does not teach electron beam cured material as the release layer. However, Hiatt teaches a heat transfer label having a support portion and a transfer portion wherein the support portion contains an electron beam cured coating layer (Fig. 4 and col. 4, line 15). He and Hiatt are analogous art because they are from the same field of endeavor that is the heat transfer label art. At the time of the invention it would have been obvious to a person of ordinary skill in the art to combine the electron beam cured coating layer of Hiatt with the invention He, and the motivation would be, as Hiatt suggests, to provide, upon transfer, a label free of residual wax on the exposed label surface (col. 3, lines 15-20).

18. Claims 7, 9 and 10: He does not teach the thicknesses of the electron beam cured layer and the protective layer in terms of lbs/3,000 sq. ft as claimed. The experimental modification of this prior art in order to ascertain optimum operating conditions fails to render applicants' claims patentable in the absence of unexpected results. *In re Aller*, 105 USPQ 233. One of ordinary skill in the art would have been

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motivated to adjust the thickness of the layers in order to ease transferability of the transfer portion and to enhance the color density of the ink design layer. A prima facie case of obviousness may be rebutted, however, where the results of the optimizing variable, which is known to be result-effective, are unexpectedly good. *In re Boesch and Slaney*, 205 USPQ 215.

19. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over He et al. (US 2005/0100689 A1) in view of Hiatt et al. (US 6,254,970 B1).

20. He teaches a heat transfer label consisting of a support portion and a transfer portion (Fig. 7 and [0114]). The support portion consisting of a paper substrate and a release layer. The paper substrate is equivalent to the claimed first layer and the release layer is equivalent to the claimed second layer. The transfer portion consisting of a wax layer and ink design layer. The wax layer is equivalent to the claimed third layer. He does not teach electron beam cured material as the release layer. However, Hiatt teaches a heat transfer label having a support portion and a transfer portion wherein the support portion contains an electron beam cured coating layer (Fig. 4 and col. 4, line 15). He and Hiatt are analogous art because they are from the same field of endeavor that is the heat transfer label art. At the time of the invention it would have been obvious to a person of ordinary skill in the art to combine the electron beam cured coating layer of Hiatt with the invention He, and the motivation would be, as Hiatt suggests, to provide, upon transfer, a label free of residual wax on the exposed label surface (col. 3, lines 15-20).



***Response to Arguments***

21. Applicant's arguments with respect to claims 1, 2, 6-12 and 14 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

22. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

23. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


24. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Betelhem Shewareged whose telephone number is 571-272-1529. The examiner can normally be reached on MAX FLEX.

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25. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

26. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BS  
October 28, 2007.

  
BETELHEM SHEWAREGED  
PRIMARY EXAMINER